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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,717	02/29/2000	Binh T. Nguyen	IGT1P030/P-282	1099
22434	7590	09/11/2002	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778			SAGER, MARK ALAN	
		ART UNIT	PAPER NUMBER	
		3714		
DATE MAILED: 09/11/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/515,717	Applicant(s) Nguyen
Examiner Sager	Art Unit 3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Jun 19, 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- 4) Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. **MARK SAGER**
PRIMARY EXAMINER

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) Other: _____

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show gaming machine comprising a master gaming controller (as presently in claim 1) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. This objection shows claimed feature of invention is not sufficiently illustrated in drawings since no ‘controller’ to conduct particular functionality of processes claimed is depicted in originally filed drawings.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: master gaming controller (clm 1), game play sequence (clm 1).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, cited claims recite a prize server comprising ‘wherein at least one gaming machine... are the same’; however, the gaming machines (400) do not form part of prize

server (402) and the preamble is not claiming either network or system, but rather the server. Therefore, the claim is confusing as to the scope of protection being sought.

Claim Rejections - 35 USC § 102

5. Claims 1-2, 4, 6-25, 27-30 and 32-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly (6015344). Kelly discloses a gaming machine such as slot machine or video card machine or roulette, a prize server, a prize distribution network and a method (1:5-15, 3:29-5:42, 6:55-61:25, figs. 1-15) teaching claimed features/steps including a master gaming controller (6:55-7:39, 8:3-24, 8:47-9:38, fig. 1-1a, 3-5b, 6-6c, 9-9a, 12-15), to receive a wager on an outcome for a game of chance (3:66-4:3, 8-14, 8:40-46, 23:40-50, 24:1-4), to receive a prize selection *corresponding to an award for at last one outcome of the game of chance* (9:61-12:47, 16:59-17:58, 21:35-63, 23:63-4:19, 24:62-25:24, 28:16-29:16, figs. 1, 3-5b, 6-6c, 9-9a, 12-14), to determine the outcome for the game of chance (3:66-4:3, 8-13, 8:40-9:31, 17:59-18:30, 23:40-50, 23:63-24:4, 10-13, 16-23, 24:62-25:24, 28:39-29:49, 32:31-46, 34:49-61, 35:31-46:22, 56:27-58:22, figs. 1, 3-5b, 6-6c, 9-9a, 12-14), to display both the outcome and the prize from a list of prizes for selection by receiving an input signal from a selection mechanism (8:40-9:38, 10:20-23, 10:50-11:23, figs. 1-1a, 3-5b, 6-6c, 9-9a, 12-14) where the display format is graphical or textual that indicates a feature such as prize value or prize theme and the prizes are cash and non-cash such as at least merchandise or shopping sprees (9:61-13:9, 27:47-28:63,, 30:8-60, 32:31-46, 34:49-61, figs. 1-1a, 3-5b, 6-6c, 9-9a, 12-14). Kelly further teaches acquisition, management, distribution and accounting of the non-cash prizes (35:31-61:42, figs. 9-15).

Claim Rejections - 35 USC § 103

6. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (6068552) in view of Kelly (6015344). Walker discloses a gaming device and method for permitting player selection of odds, payout schedule or prize level and wager amount so the player inputs preferences which encourages them to play longer thereby generating higher revenues for the casino due to the longer play session (1:5-7, 2:1-41; 3:10-11:42, esp. 3:40-11:20, figs. 1-12) teaching claimed features/steps including memory storing a list of prizes cash, prize display mechanism displaying prizes stored in the memory, prize selection mechanism used to select prizes for game outcomes of a game played on a game machine with display wherein the prizes are cash and a server comprising an interface for providing information to gaming machines. Further, Walker teaches a gaming machine, a prize server , a prize distribution network and a method comprising a master gaming controller (figs. 1-12, ref. 102) to receive a wager (refs. 217-219, 316), to receive a prize selection (figs. 1-9b, ref. 312), to determine the outcome (4:2-10, figs. 1-12), to display the outcome and any prize awarded (4:2-10, 4:45-10:6, figs. 1-12), to award the selected prizes (3:35-4:12). However, Walker does not disclose ‘non-cash’ prizes (clms 1, 14, 21, 24, 35), ‘theme’ (clm 13) ‘merchandise, vacations, airline miles or shopping sprees’ (clms 2, 15, 23, and 37), portable memory device is a magnetic card, personal digital assistant or smart card (clms 27, 28, 40), ‘printing a record’ (clm 41), ‘prize fulfillment information used to redeem prizes won by players playing gaming machines’ (clm 43) and a ‘prize fulfillment center that is used to acquire and deliver prizes’ (clm 44). This lack of disclosure does not teach away from claimed invention since the standard of patentability is what the prior art

taken as a whole at a time prior to the invention suggests to an artisan. In this case, regarding claims 1-2, 14-15, 21, 23-24, 35 and 37, casinos offer or cater to player gaming preferences including prize preferences to attract them to play at their casino so as to increase their revenue thereby since the longer players continue to play the more the casinos' revenue is likely to increase (Walker, 1:5-40, 53-65). Player preferences include preferences for mode of prize being either cash or non-cash winnings since some players prefer to receive cash payout while others prefer non-cash prizes as known and as admitted prior art. Walker teaches system, method or machine to cater to player preferences including for amount of wager and size or amount of cash prize (2:1-41), but lacks disclosing non-cash prizes. Non-cash prizes, such as merchandise, vacations, airline miles or shopping sprees, are notoriously well known as 'theme' prizes having intrinsic monetary value which are monetarily equivalent prizes to the cash prizes taught by Walker. Applicant's admission in instant background that cash and non-cash prizes as payout (1:7-3:20) such that some players are motivated to play dependent on preference for cash or non-cash prizes such as cruises or automobiles (3:12-13) and in remarks filed Jan 14, 2002 (page 5) is noted. Kelly discloses a system, machine and method for player selection of prizes from a list of prizes stored in memory either on a gaming machine with a display for displaying the list of prizes or on a server having an interface for communication with gaming machines including wagering on games of chance (supra) teaching selecting prizes of cash (9:14-16, 9:61-10:2) and 'non-cash' prizes such as merchandise or shopping spree (9:61-10:5; 11:47-63, 24:62-25:32; 29:40-30:18, 32:31-47, figs. 1-15, esp. 6-6c and 9, or 32:31-46 for tournament play) from a selection menu (figs. 1-1a, 3-5b, 6-6c, 9-9a, 12-14) including 'theme' prizes (9:61-10:2, 11:47-63, 30:8-18)

which include promotional awards by voucher or certificate for shopping spree at particular sponsor (11:47-61, 30:8-60, 32:31-47) where non-cash prizes are monetarily equivalent to cash prizes due to their intrinsic cash value to cause greater interest and involvement and thus increases the games earnings thereby (24:16-19) by allowing players to view and select cash or non-cash prizes (9:61-10:2, 20-23). Kelly further teaches awarding non-cash prize or monetary equivalent amount for shopping spree (34:49-57). Therefore, it would have been obvious to an artisan at time prior to invention to add ‘non-cash’ selected from the group of ‘merchandise, vacations, airline miles, shopping sprees’ and ‘theme’ as notoriously well known by Applicant’s admissions (*supra*) or as monetarily equivalent or as taught by Kelly to Walker’s game device and method to provide alternate equivalent payout or to motivate players to play longer by providing prizes of players’ personal preference (Applicant’s admission) or to cause greater interest and involvement and thus increases the games earnings thereby (Kelly, 24:16-19) by allowing players to view and select cash or non-cash prizes (Kelly, 9:61-10:2, 20-23). Kelly further teaches acquisition, management, distribution and accounting of the non-cash prizes (35:31-61:42, figs. 9-15).

Further, regarding portable memory device is a magnetic card, personal digital assistant or smart card (clms 27, 28, 40), ‘printing a record’ (clm 41), ‘prize fulfillment information used to redeem prizes won by players playing gaming machines’ (clm 43) and a ‘prize fulfillment center that is used to acquire and deliver prizes’ (clm 44), Kelly teaches portable memory device is a magnetic card, personal digital assistant or smart card to allow transfer of stored selected prizes to be recorded onto portable magnetic media so as to allow prize claim at another or remote location by card reader (11:20-23; 15:66-16:5; 17:16-20, 39-58; 28:39-63), ‘printing a record’

(11:64-12:21), ‘prize fulfillment information used to redeem prizes won by players playing gaming machines’ (28:39-63, figs. 1-15) and a ‘prize fulfillment center that is used to acquire and deliver prizes’ (28:39-63, figs. 1-15) for stocking and delivering non-cash prizes. Kelly also teaches accounting or adjusting probability based in part on the intrinsic cash value of the non cash prizes (figs. 9-15). Therefore, it would have been obvious to an artisan at a time prior to the invention to add portable memory device is a magnetic card, personal digital assistant or smart card, ‘printing a record’, ‘prize fulfillment information used to redeem prizes won by players playing gaming machines’ and a ‘prize fulfillment center that is used to acquire and deliver prizes’ as taught by Kelly to Walker’s gaming device and method to allow prize claim of player selected non-cash prize at another or remote location having a reader and to stock and deliver non-cash prizes.

Therefore, in this instance, when the prior art is taken as a whole at a time prior to the invention, Walker in view of Kelly suggests to an artisan a gaming machine, server, network or method, as claimed, permitting player selection of either cash or non-cash prizes (which have an intrinsic monetary value that is monetarily equivalent to cash prizes or provided to cater to player preference) based on the players’ preference so as to encourage players to continue to play longer which generates increased revenue for the casino from the longer play session.

7. Claims 3, 5, 26 and 31 are rejected as unpatentable under 35 U.S.C. 103(a) as being unpatentable over Kelly (6015344) in view Walker et al (6068552). Alternatively, Kelly discloses a system, machine and method teaching claimed invention (supra) including adjusting the probability or hit ratio based in part on the value of prize (35:31-61:25, figs. 1-15, esp. 9-9b)

except ‘specific to a wager amount’ (clm 3), ‘probability of the outcome... specific to a value of the selected prize’ (clm 5), ‘determining a payable... chosen according to the value of the prize selected’ (clm 26) and ‘specific to the wager amount’ (clm 31). This lack of disclosure does not teach away from claimed invention since the standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan. In this case, Walker discloses a gaming machine, server and method (*supra*) teaching ‘specific to a wager amount’ (3:48-64, 4:49-11:42, figs. 1-12, ref. 316), ‘probability of the outcome... specific to a value of the selected prize’ (*supra*), ‘determining a payable... chosen according to the value of the prize selected’ (*supra*) and ‘specific to the wager amount’ (*supra*) to encourage players to continue playing longer by permitting players to configure game play according to their preferences including prize or wager so as to increase revenues generated thereby (1:5-41, 2:1-41). Therefore, in this instance, when the prior art is taken as a whole at a time prior to the invention, Kelly in view of Walker suggests to an artisan a gaming machine, server or method, as claimed, permitting player selection including wager or prize of either cash or non-cash prizes (which have an intrinsic monetary value that is monetarily equivalent to cash prizes or provided to cater to player preference) based on the players’ preference so as to encourage players to continue to play longer which generates increased revenue for the casino from the longer play session (Walker, 1:5-41, 2:1-41).

Response to Arguments

8. Applicant's arguments filed June 19, 2002 have been fully considered but they are not persuasive. Regarding Applicant's assertion that Kelly 'does not describe a gaming machine that can be used to make a wager on the outcome of a game of chance played on the gaming machine'

and ‘Wagers on the outcome of a game of chance’, the examiner respectfully disagrees since Kelly clearly teaches wagering on an outcome in games of chance (3:66-4:3, 4:8-13, 4:23-32, 4:56-5:6, 9:61-5, 10:50-11:63, 23:40-50, 24:1-23, 24:62-25:24, esp. 24:62-25:24, figs. 1, 3-5b, 6-6c).

Regarding Applicant’s remark that Kelly teaches a ‘specific prize can also be won where the player can receive the prize due to a particular result winning result on the game unit (remarks page 6, bottom paragraph, including citing Kelly, 10:54-57), the examiner agrees. However, regarding Applicant’s assertion that Kelly does not describe the ‘ability to select a prize corresponding to the outcome of a game of chance or ‘selecting a prize as an award for the outcome of a game of chance on which a wager has been made’, the examiner respectfully disagrees. In particular, Kelly teaches player can choose to play a game where the player receives specific prizes based on outcomes of the game (24:1-4), where the player selects game button 312 for insta-prizes which ‘causes a list to be displayed of specific prizes that will be awarded under predetermined conditions [an outcome] for the next predetermined number of the selected games played on the game apparatus (24:62-25:24, figs. 1, 3-5b, 6-6c). Further, the instant invention fails to preclude Kelly’s teachings due to the breadth of claim language. For instance, the claims lack a temporal limitation for steps receiving a prize selection and determining the outcome such that Kelly’s system includes determining the outcome and receiving a prize selection (instant remarks page 6, bottom paragraph, citing Kelly, 10:15-17, 10:30-36 and 10:54-57) anticipates claimed invention, as broadly claimed. The claim language comprising ‘an outcome’ also fails to preclude Kelly’s system in that the outcome includes a predefined goal or event (23:40-50, 23:63-24:4, 16-23, 24:62-25:24, figs. 1, 3-5b, 6-6c, ref. 312) over a plurality of plays/wagers in a game

sequence in a gaming session. The claim language comprises receiving/to receive 'a prize selection corresponding to an award for at least one outcome' (clms 1, 14, 21, 35) which fails to preclude Kelly's prize selection (figs. 1, 3-5b, 6-6c, 9-9a, 14).

Regarding Applicant's remark that '**Kelly clearly states that it is difficult to provide non-cash prizes**' (emphasis by Applicant), the standard of patentability is not whether it is difficult, but remains as what the prior art taken as a whole at a time prior to the invention suggests to an artisan. In this instance, the particular admission by Kelly is for failings of redemption games prior to Kelly's invention. It is noted that Applicant lacks consideration in this statement concerning Kelly's relevant teachings to overcome those difficulties (1:5-15, 3:29-5:41, 6:55-61:42, figs. 1-15) and thus fails in considering the art as a whole. In addition, it is noted that Kelly is analogous prior art for being either in the Applicant's field of endeavor or reasonably pertinent to the particular problem with which the applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this instance, Walker discloses a gaming device and method for prize selection but lacks non-cash prizes such as merchandise, vacations, airline miles, or shopping sprees. Non-cash prizes are monetarily equivalent to cash prizes taught by Walker. Further, Applicant's admission that some players are motivated to play dependent on preference for cash or non-cash prizes such as cruises or automobiles (3:12-13) and in remarks filed Jan 14, 2002 (page 5) is noted. Finally, Kelly discloses a prize system (3:29-5:41, 6:55-61:43, figs. 1-15) teaching selection of cash and non-cash prizes such as merchandise or shopping sprees to cause greater interest and involvement and thus increases the games earnings thereby (24:16-19) by allowing players to view and select cash or non-cash prizes (9:61-10:2, 20-23).

Kelly further teaches acquisition, management, distribution and accounting of the non-cash prizes on the prize server and associating payout with hit ratio of game and cost associated with non-cash prizes (35:31-61:42, esp. 35:31-45:67, figs. 9-15, refs. 470, 472, 474, 476, 478, 480, 482) which is analogous to formulas for calculating the cash prizes and hit ratios within Walker.

Further, Kelly is analogous prior art for being in the field of games including wagering on games of chance having prize selection from a list of prizes and a prize distribution center for acquiring, managing and delivering prizes awards or Kelly is reasonably pertinent to the particular problem with which the Applicant was concerned for providing a gaming machine, server/network or method for allowing players to select prizes including cash and non-cash from prize list and for distributing those prize awards (*supra*). Therefore, Kelly is analogous prior art. Thus, in this instance, when the prior art (Walker, Kelly, and admissions) is taken as a whole at a time prior to the invention, the combination suggests to an artisan a gaming machine, a prize server, a network, or a method to receive a wager, to select a prize, to determine an outcome, to display an outcome and prizes and to award prizes selected from prize list where the prizes are cash and non-cash such as merchandise, vacations, airline miles, or shopping sprees to cause greater interest and involvement and thus increases the games earnings thereby (24:16-19) by allowing players to view and select cash or non-cash prizes (9:61-10:2, 20-23). The calculation of prize awards within Walker are pertinent to the calculation of non-cash awards taught by Kelly due to monetary equivalence and Kelly teaching how to account/manage the costs of non-cash prizes with associating payout with hit ratio of game (*supra*) to cause greater player interest and involvement and thus increases the game's earnings (Kelly, 24:16-29).

Regarding Applicant's assertion that [Walker's] figures do not show or suggest any non-cash prizes, it is noted that the holding is obviousness under 103 rather than anticipation. The suggestion for combination is as stated above incorporated herein equivalence of prizes or admissions of known to provide both cash or non-cash prizes due to some players prefer non-cash awards (*supra*) or Kelly's teachings to cause greater player interest and involvement and thus increases the games earnings thereby (24:16-19) by allowing players to view and select cash or non-cash prizes (9:61-10:2, 20-23, 25:17-24).

9. Applicant's arguments with respect to claims 14-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adams discloses game machine awarding cash and non-cash prizes such as merchandise or vacation.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Tom Hughes, can be reached on (703) 308-1806. The fax phone number for this Group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. A. Sager
Primary Examiner
Aug. 30, 2002